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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,139	02/11/2008	Neil Duggal	HO-P03203US0	5647
44270	7590	01/21/2011		
IMDS, INC.	EXAMINER			
124 SOUTH 600 WEST	SNOW, BRUCE EDWARD			
LOGAN, UT 84321				
		ART UNIT	PAPER NUMBER	
		3738		
NOTIFICATION DATE	DELIVERY MODE			
01/21/2011	ELECTRONIC			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

khansen@imds.net

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/590,139	DUGGAL ET AL.
	<b>Examiner</b> Bruce E. Snow	Art Unit 3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on 06 December 2010.
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 32-38, 41, 43-45, 48, 50-56, 58-61, 63-66 and 68-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 32-38, 41, 43-45, 48, 50-56, 58-61, 63-66, 68-71 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a)  All    b)  Some \* c)  None of:
  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>11/4/10, 11/4/10</u>	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

### DETAILED ACTION

#### *Response to Arguments*

Applicant's arguments filed 12/06/10 have been fully considered. Regarding claim 56, applicant arguments are persuasive. Said claim has been added back into prosecution.

Applicant's amendments to claims 32, 41, 51, and 58, describing the articulating surfaces of the nucleus and bottom plate are planar or flat, as shown in the drawing, overcame the anticipation rejections of Zucherman et al (7,320,707) and Marik et al (2005/0216086).

11/19

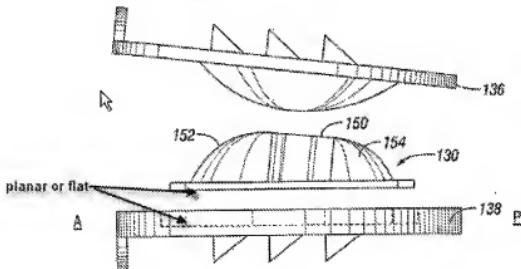


FIG. 25

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 32-38, 41, 43-45, 48, 50-56, 58-61, 63-66, 68-71 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over all claims of copending Application No. 11/559,215. Although the conflicting claims are not identical, they are not patentably distinct from each other. Applicant is has elected to prosecute the same species in both cases. The same species contains the same limitations. This application as since been allowed, however, as of today does not have a patent number. The following is the allowed claim 30 from Application No. 11/559,215.

30. (Currently Amended) The intervertebral disc prosthesis of claim 24, An intervertebral disc prosthesis comprising:

\_\_\_\_\_ a first end plate securable to a first vertebral body of a portion of a spine, the first end plate comprising a first articular surface;

\_\_\_\_\_ a second end plate securable to a second vertebral body of the portion of the spine, the second end plate comprising a fourth articular surface; and

\_\_\_\_\_ a nucleus positioned between the first and second end plates, the nucleus formed separately from the first and second end plates, the nucleus comprising a second articular surface that articulates with the first articular surface and a third articular surface that articulates with the fourth articular surface;

\_\_\_\_\_ wherein the nucleus comprises an asymmetrical shape across a coronal plane of the first and second vertebral bodies, the asymmetrical shape tending to urge the first and second end plates to remain in a relative orientation that provides a preferred lordotic or kyphotic angle between the first and second vertebral bodies;

\_\_\_\_\_ wherein line contact is provided between the first and second articular surfaces when the first articular surface articulates relative to the second articular surface in the anterior/posterior direction; and

\_\_\_\_\_ wherein the third and fourth articular surfaces are substantially entirely planar to permit translational movement in at least one of the anterior-posterior and medial-lateral directions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

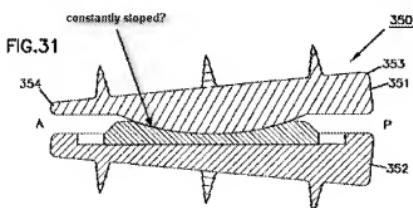
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32-38, 41, 43-45, 48, 50-56, 58-61, 63-66, 68-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 uses claim very broad claim terminology which is not supported by the specification. Due to the very broad language, the claim is indefinite. The following claim limitations are indefinite: articulating structure, first and second articulating surfaces, third and fourth articulating surfaces. Please diagram the claim. The examiner notes applicant changes the surfaces through-out the claims making them inconsistent. It is noted this claim is very similar to allowed claim 30 from Application No. 11/559,215. However, allowed claim defines the surfaces unlike that current claim 32.

Claim 32, what is the "articulating structure", the nucleus? How can it have first and second articulating surface that are constantly sloped? Please direct to the specification for support and description and the drawings.

Claim 32, "constantly sloped" is unclear if it means having a constant slope or the slope is constantly sloping or changing. Referring to figure 31 of the prior art U.S. 6,368,350, is the top surface of the nucleus "constantly sloped"?



Claim 41 is not understood. Please diagram the claim. Is the second articular surface the same element as that in claim 32, 51, 58?

Claim 51, "the first end plate comprising a first articular surface comprising a first straight portion in at least one cross section" is unclear. How is it straight in more than one cross section?

Claim 58 is ambiguous. Line 7, "a straight portion in at least one cross" is unclear. How is it straight in more than one cross section?

Claim 58, lines 4 claims "a plurality of bone engagement features" which is the same or different than "a pair of individual projections" (line 7)?

Claim 58, what is the pair of individual projections? Please direct to the specification and drawings for support.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: constantly sloped, articulating structure, first and second articulating surfaces, third and fourth articulating surfaces, first straight section, pair of individual projections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruce E Snow/  
Primary Examiner, Art Unit 3738